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IfwIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

Collier, David C.

Serial No.: 10/081,173

Filed: February 22, 2002

For: METHOD, APPARATUS AND SYSTEM FOR  
SECURELY PROVIDING MATERIAL TO A  
LICENSEE OF THE MATERIAL

Confirmation No.: 2754

Group Art Unit: 3621

Examiner: Worjloh, Jalatee

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450INFORMATION DISCLOSURE STATEMENT

Sir:

Enclosed is a copy of Information Disclosure Citation Form PTO-1449 or PTO/SB/08 together with copies of the documents cited on that form, except for copies not required to be submitted (e.g., copies of U.S. patents and U.S. published patent applications need not be enclosed). It is respectfully requested that the cited documents be considered and that the enclosed copy of Information Disclosure Citation Form PTO-1449 or PTO/SB/08 be initialed by the Examiner to indicate such consideration and a copy thereof returned to applicant(s).

Pursuant to 37 C.F.R. § 1.97, the submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made and is not to be construed as an admission that the information cited in this statement is material to patentability.

Pursuant to 37 C.F.R. § 1.97, this Information Disclosure Statement is being submitted under one of the following (as indicated by an "X" to the left of the appropriate paragraph):

- \_\_\_\_\_ 37 C.F.R. §1.97(b).
- X   37 C.F.R. §1.97(c). If so, then enclosed with this Information Disclosure Statement is one of the following:
- X   A statement pursuant to 37 C.F.R. §1.97(e) or
- \_\_\_\_\_ Charge the required fee of \$180.00 for the fee under 37 C.F.R. § 1.17(p) to Deposit Account No. **13-0762**.
- \_\_\_\_\_ 37 C.F.R. §1.97(d). If so, then enclosed with this Information Disclosure Statement are the following:
- (1) A statement pursuant to 37 C.F.R. §1.97(e); and
  - (2) A check for \$180.00 for the fee under 37 C.F.R. §1.17(p) for submission of the Information Disclosure Statement.

Pursuant to 37 C.F.R. §1.98(a)(3)(i) and (ii), English translations of the Japanese Office Action and the abstracts of published Japanese patent applications referenced therein are also provided herewith.

If any fees are required, please charge the required fees to Deposit Account No. 13-0762.

Respectfully submitted,  
MACROVISION CORPORATION

Dated: 10/18, 2006

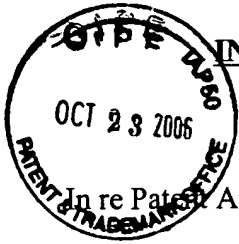
George B. Almeida  
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**FIRST CLASS CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 18, 2006

Claire Walters  
Name of Person Mailing Correspondence  
Claire Walters 10/18/2006  
Signature Date



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Collier, David C.

Serial No.: 10/081,173

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For: **METHOD, APPARATUS AND SYSTEM FOR  
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P.O. Box 1450  
Alexandria, Virginia 22313-1450

Confirmation No.: 2754

Group Art Unit: 3621

Examiner: Worjloh, Jalatee

**STATEMENT UNDER 37 C.F.R. 1.97(e)**

Sir:

I hereby certify (as indicated by an "X" to the left of the appropriate paragraph):

X That each item of information contained in the accompanying Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement.

\_\_\_\_\_ That no item of information contained in the accompanying Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned attorney after making reasonable inquiry, no item of information contained in the Information Disclosure Statement was known to any individual designated in §1.56(c) more than three months prior to the filing the Information Disclosure Statement.

Respectfully submitted,  
MACROVISION CORPORATION

Dated: 10/18, 2006

George B. Almeida  
George B. Almeida (Reg. No. 20,696)

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Claire Wallters  
Name of Person Mailing Correspondence

Claire Wallters  
Signature

10/18/2006  
Date

**TRANSLATION OF AN OFFICE ACTION  
of Japanese Patent Office**

Re: Japanese Patent Application No.2003-536857  
Patent Office Examiner: Nobuyuki ISHIDA  
Dated: July 13, 2006  
Mailed: July 18, 2006  
Attorney for Applicant: Tadahiko Itoh  
Applied Provisions: Patent Law Sections 29, 29(2), 36

The present application is found to be rejected for the following reason(s). If the applicant wishes to respond to the Reason(s) for rejection, an argument(s) and/or amendment(s) can be submitted within three (3) months from the mailing date of this Office Action. The due date can be extended by three (3) months one time, if a request for such extension is filed within three (3) months from the mailing date of this Office Action.

**Reason(s)**

Reason 1. The examiner contends that:

The invention described in the present applicant's Claim(s) indicated below could have been easily invented by those skilled in the art based on the following reference(s) published before the priority date of the patent application. Therefore, the present application is found un-patentable by virtue of the provision in Article 29, Paragraph 2 (Un-obviousness or Inventive Step), of the Japanese Patent Law.

Reason 2. The examiner contends that:

The present application's Claims are not allowable because they do not meet the requirement stipulated in the preamble of Article 29(1) (Industrial Applicability) of the Japanese Patent Law.

Reasons 3. The examiner contends that:

The Claims of the patent application do not meet the requirement stipulated in Article 36, Paragraph 6, item (ii) (Definiteness of Claimed Invention) of the Japanese Patent Law.

**- THE LIST OF CITED DOCUMENTS**

- Reference 1.:Japanese Laid-open Patent Application  
No.2001-175606  
Reference 2.:Japanese Laid-open Patent Application  
No.2000-83233  
Reference 3.:Japanese Laid-open Patent Application  
No.2000-83022

**Note**

Reason 1

Claims: 1-47  
Reference: 1-3  
[Remarks]

Reference 1 discloses a method, an apparatus and a system for securely providing contents to a user of the contents, comprising: providing a right data and a license key to the user of the contents; providing the contents encrypted with the contents key to the user; providing the contents key encrypted with the license key to the user in a secure container provided with the contents (figure 1-3, 6, 7, 17-20, 35, 36, 39, 40, 48, 84, 97 and corresponding explanations).

Reference 2 (figure 4 and paragraph [0045]) and Reference 3 (figure 4 and paragraph [0022]) disclose to provide the user with the information by an IPMP stream added to MPEG-4 bit stream.

It is obvious for those skilled in the art to achieve the claimed inventions by combining reference 1 with reference 2.

Reason 2  
[Remarks]

Regarding 1, 2, 5, 6, 7, 8, 41, 43, 44, 46 and 47, since it is unclear whether a server or a client performs steps in the claims, these method are not statutory inventions, they do not meet the requirement stipulated in the preamble of Article 29(1) (Industrial Applicability) of the Japanese Patent Law.

Reason 3.  
[Remarks]

It is unclear the relations between claimed elements/steps in the following issues:

- (1) Regarding 1-47, it is unclear whether "a licensee" is "a person" or "an apparatus".
- (2)-(12) Regarding 15, 16, 18, 19, 26, 27, 29, 30, 37, 38, 40, it is unclear what (what means or element) performs the claimed function.

No rejection reasons were found in this Office Action other than those indicated above. If a new rejecting reason is found, the Japanese Patent Office will issue another Office Action.

Substitute for Form 1449/PTO <b>INFORMATION DISCLOSURE</b> <b>STATEMENT BY APPLICANT</b> <i>(use as many sheets as necessary)</i>			<b>Complete if Known</b>			
			Application Number	10/081,173		
			Filing Date	February 22, 2002		
			First Named Inventor:	David C. Collier		
			Art Unit	3621		
			Examiner Name	Worjloh, Jalatee		
			Attorney Docket Number	0213		
Sheet	1	Of				
<b>U.S. PATENT DOCUMENTS</b>						
Examiner Initials*	Cite No. <sup>1</sup>	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)				
		US-				
		US-				

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
		JP	2001-175606		6-29-2001	Sony Corp.		
		JP	2000-083233		03-21-2000	Canon Inc.		
		JP	2000-083022		03-21-2000	Canon Inc.		

NON PATENT LITERATURE DOCUMENTS		
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published
		Patent Abstracts of Japan for JP 2001-175606 published 06-29-2001, 1 page.
		Patent Abstracts of Japan for JP 2000-083233 published 03-21-2000, 1 page.
		Patent Abstracts of Japan for JP 2000-083022 published 03-21-2000, 1 page.

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SENT FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Based on Form PTO/SB/08A (08-03) as modified by Macrovision Corporation on 02/03/05.